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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,274	01/25/2001	Werner Temme	24487	3642

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09/21/2005

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EXAMINER

NILAND, PATRICK DENNIS

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/768,274

Applicant(s)

TEMME ET AL.

Examiner

Patrick D. Niland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/12/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-22 and 24-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-22 and 24-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/12/05 has been entered.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 18-22 and 24-28, 30, 32-34, and 37-38 are rejected under 35 U.S.C. 102(a or e) as being anticipated by US Pat. No. 5912298 Gomi et al..

Gomi discloses coating flooring with compositions falling within the scope of those of the instant claims. All such coated floors have the ability to have sports played on them. The patentee does not specify the type of average molecular weight but my polymer chemistry professor stated that, in such instances, number average is presumed. In any event, the

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polydispersity of such reactions, i.e. about 2, will also give molecular weights within the claimed range even if weight average were meant by the patentee. See the abstract; column 2, lines- 45-67; column 3, lines 1-67, particularly 26-50; column 4, lines 1-67, particularly 4-8, 24-31, and 36-46; column 5, lines 1-67, particularly 19-42, which fall within the scope of the fillers of the instant claims 24-26 and 28; column 6, lines 1-67; column 7, lines 1-67, particularly 38-67; column 8, lines 1-67, particularly 9-27; and the remainder of the document. The prior art use of salt groups which render the polyurethane from dispersible to soluble will necessarily give the particle sizes of the instant claim 22. The composition of the patentee bonds to the substrate and is therefore a "bonding agent". It will necessarily seep between cracks in wood floors and bond these sections together by virtue of the intrinsic adhesive nature of polyurethanes used by the patentee. It is not seen that the composition of the patentee cannot be sprayed and such dispersions certainly flow. This ability to flow and form a film will necessarily give sealed pores in the substrate of the patentee.

5. Claims 18-22 and 24-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5912298 Gomi et al..

Gomi discloses coating flooring with compositions falling within the scope of those of the instant claims. All such coated floors have the ability to have sports played on them. The patentee does not specify the type of average molecular weight but my polymer chemistry professor stated that, in such instances, number average is presumed. In any event, the polydispersity of such reactions, i.e. about 2, will also give molecular weights within the claimed range even if weight average were meant by the patentee. See the abstract; column 2, lines- 45-67; column 3, lines 1-67, particularly 26-50; column 4, lines 1-67, particularly 4-8, 24-31, and

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36-46; column 5, lines 1-67, particularly 19-42, which fall within the scope of the fillers of the instant claims 24-26 and 28; column 6, lines 1-67; column 7, lines 1-67, particularly 38-67; column 8, lines 1-67, particularly 9-27; and the remainder of the document. The prior art use of salt groups which render the polyurethane from dispersible to soluble will necessarily give the particle sizes of the instant claim 22. The composition of the patentee bonds to the substrate and is therefore a "bonding agent". It will necessarily seep between cracks in wood floors and bond these sections together by virtue of the intrinsic adhesive nature of polyurethanes used by the patentee. It is not seen that the composition of the patentee cannot be sprayed and such dispersions certainly flow. This ability to flow and form a film will necessarily give sealed pores in the substrate of the patentee.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use fillers in the coating of the patentee because they are well known for use in coatings and would have been expected to give their known properties to the final coating of Gomi, which falls within the scope of the instant claims 24-26 and 28.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the amines of the instant claims 29, 31, 35 in the coating of the patentee because they are well known for use in polyurethanes to keep them from yellowing and are commercially available for this purpose.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the coating thickness/amount of polyurethane per area of the instant claims 36-37 because this gives only predictable results to the ordinary skilled artisan and is within the ability of the ordinary skilled artisan to choose as evidenced by the patentee's silence to this

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parameter. It is not seen that the method of the patentee does not necessarily inherently fall within the parameters of claims 36-37.

6. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patrick D. Niland
Primary Examiner
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